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No. 06-443

IN THE
# Supreme Court of the United States

MARK BRUCKELMYER,

*Petitioner*,

v.

T.H.E. MACHINE COMPANY,

*Respondent.*

**On Petition for Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit**

## REPLY TO OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

JOHN B. LUNSETH, II
*Counsel of Record*
Briggs and Morgan, P.A.
2200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
(612) 977-8400

*Counsel for Petitioner*

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## ARGUMENT

### A. Bruckelmyer's Petition is Appropriate for Certiorari Review

T.H.E. Machine Company ("T.H.E.") and Ground Heaters, Inc. ("Ground Heaters") argue that this case has no jurisprudential importance because there is no conflict between the Circuit Courts of Appeal or with an earlier Federal Circuit decision.[1] This assertion is wrong.

For several decades the Federal Circuit's predecessor court followed the "plain meaning" rule of statutory interpretation in applying 35 U.S.C. §§ 102 (a) & (b), requiring that foreign prior art must be a "printed publication." *See In re Tenney,* 254 F.2d 619 (C.C.P.A. 1958). The C.C.P.A. "reinterpreted" the statute and applied its own standard in 1981 based on whether the prior art is "accessible," requiring that the Courts parse through the issue on a case-by-case, fact intensive basis. *See In re Wyer,* 655 F.2d 221 (C.C.P.A. 1981). While this is a time-honored way for the Court to proceed with the development of common law rules to meet advancing technology, it can also be a slippery slope, particularly in the field of statutory interpretation. Each new decision departs imperceptibly from the original statutory standard until that standard no longer exists. Since the *Wyer* decision, the Federal Circuit has applied the "accessibility" standard, straying ever farther from Congress's original intent in creating the "printed publication" rule.

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[1] T.H.E. joined the arguments and factual assertions made in the *Amicus Curiae* Opposition to Petition for Writ of Certiorari of Ground Heaters, Inc. The arguments in both oppositions are jointly addressed by this Reply.

This case is ripe for certiorari because the Federal Circuit majority, with its holding in this case, finally fell down the slippery slope. The majority made a ruling under which any document found in any file in any patent office in the world can be considered a printed publication, regardless of whether that document was created and handled in a way intended to impart its teachings to the U.S. public. Its mere existence, without more, is enough.

Judge Newman and Judge Linn make clear the dissidence among the Federal Circuit judges about what standard should be used to assess "printed publications." Judge Newman correctly labels the majority's standard as "unsupported by precedent" and calls for consistency among the Federal Circuit judges. (20a.) In pointing out the different interpretations of "printed publication," Judge Newman sensibly notes "[w]e should maintain a consistent and reliable standard of what constitutes a 'printed publication.'" (*Id.*)

The joint dissent of Judge Newman and Judge Linn does more than just take "issue with the legal conclusion drawn by the majority under this case's specific facts." (T.H.E.'s Opposition, p. 5.) The dissent correctly concludes that the majority opinion departs from Congress's intent in drafting 35 U.S.C. §§ 102(a) and (b). The majority's opinion treats as "printed publications" three documents that are stored on microfiche in the CIPO and are not referenced, indexed or cataloged in any way. The majority held the file wrapper was "publicly accessible," in that one could go to the CIPO and get a copy. The flaw in this analysis is revealed in the dissent's application of the original standard for "printed publications," which held foreign prior art to a strict standard by requiring that it be printed and published. (17a.) In evaluating this standard, Judges Newman and Linn recognize that foreign documents must be in a form in which it is likely they will be disseminated to the U.S. public. (*Id.*)

The Federal Circuit judges *do* disagree on the appropriate legal standard to apply to foreign prior art. Two judges have stated fairly emphatically and without reserve that the majority's standard is wrong. The majority decision shows that the Federal Circuit has departed from the intent of Congress and has legislated from the bench. This disagreement within the Federal Circuit can only be resolved by this Court, and is thus appropriate for review. This question is an important question of federal law that must be decided by this Court.

**B. Bruckelmyer's Argument was Raised in a Timely Fashion**

T.H.E. and Ground Heaters are also misguided in contending that the question presented to this Court is untimely. (T.H.E. Opposition, pp. 6-7; Ground Heaters's *Amicus Curiae* Opposition, p. 7.) The issue was not appropriate in the courts below because before the Federal Circuit majority's aberrant ruling in this case, the "accessibility" approach was still being used to hold foreign prior art to a higher standard than documents from the United States. The Federal Circuit, however, has now taken the "accessibility" standard to its ultimate limit by treating as a printed publication any foreign prior art in a patent office that can physically be accessed by any member of the public. In other words, any document lying in a patent office anywhere in the world is now considered invalidating prior art, regardless of whether it is properly indexed or cataloged, or whether it was ever produced in a way calculated to impart its teachings to the U.S. public.

Now is the appropriate time to correct the Federal Circuit's misapplication of the "printed publication" doctrine. Only this Court can stop the Federal Circuit's persistence in progressing to a rule and a result that holds, *sub silencio*, that the statutory language and Congress's

intent are obsolete and should be replaced with a judicially refashioned standard

The cases cited by T.H.E. in arguing lack of timeliness are inapplicable to the case at hand. In both *Pentax Corp. v. Robison*,135 F.3d 760 (Fed. Cir. 1998) and *Clingman v. Beaver*, 544 U.S. 581 (2005) the appellant attempted to raise new statutory claims at the appellate level that were not raised below. In *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1240 (Fed. Cir. 1997), the appellant offered new definitions for key patent terms that were not offered below. In all three cases, litigants attempted to raise new subject matter at a late stage in the appeal process. However, Bruckelmyer's issue has always been that these documents do not meet the definition presented in 35 U.S.C. §§ 102(a) and (b). Calling to the attention of the Court of Appeals, in a Petition for Rehearing or Rehearing En Banc, the effect of a panel decision is not untimely; nor is the appeal to this Court.

The court in *Tenney* and Judge Newman and Judge Linn's dissent explain Congress's intent in writing the "printed publication" bar. The purpose behind the prior art restrictions is to prevent a patent on an idea that is already in the public realm. *In re Tenney*, 254 F.2d at 635. Congress holds foreign documents to a higher standard than documents originating in the United States because they are inherently less likely to be known by the U.S. public. To articulate this higher standard, Congress created the "printed publication" requirement. Congress held that one who "prints" a document does so with the intent of publicly distributing it. *See In re Tenney*, 254 F.2d at 626. "Congress no doubt reasoned that one would not go to the trouble of printing a given description of a thing unless it was desired to print a number of copies of it." *Id.* Congress decided that foreign prior art should only invalidate U.S. patents if it were proven to be printed and in a form intended to be published to the public for ready access. *Id.*

> The earlier cases decided by the CCPA interpreted 'printed' as Congress no doubt understood the term: multiple copies that were made in order to disseminate the information. The idea that the information would, at least in principle, be available to interested persons in the United States.

(18a.)

The three documents in the '119 file wrapper cannot be considered as "printed publications" because microfilm and microfiche, without more, do not meet this definition. This is why the court in *Tenney* refused to treat the microfilmed documents as invalidating prior art. *In re Tenney*, 254 F.2d at 627. Microfilm or microfiche are merely handy ways for patent offices to store records for review, so that access to the originals – which over time can cause damage to the originals – can be conducted. They do no more than what is accomplished by keeping the paper file in the patent office, they maintain it for future reference and review. Congress chose "printing" in the "printed publication" rule, because one who goes to the trouble of printing a document does so in order to actively publicly disseminate it. Microfilm and microfiche, or storage of an unindexed file on a shelf, are merely an alternative means of storage to preserve the originals, they indicate no purpose to disseminate. In any event, the decision is one for Congress to make. Congress can, if it wants to, adopt the "accessibility" rule that the present case stands for. It has not done so. Thus the Federal Circuit's holding that the microfilm document is a printed publication does not abide by the standard created by Congress that printing must be done for the purpose of making many copies of a document.

### C. The Federal Circuit's Holding is Not a Mere Adjustment for Modern Technology

Ground Heaters argues that the Federal Circuit's opinion, and the opinion in *Wyer*, follow the Court's policy of keeping up with new technology when interpreting congressional intent. (Ground Heaters's *Amicus Curiae* Opposition, p. 9.) Ground Heaters compares Bruckelmyer's argument to saying that a 19th-century statute criminalizing "theft of goods" would not apply to a stolen microwave oven, as that was not a "good" in the 19th century. (*Id.*, citing *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281, 316 (1988).) This argument is simply a mistake in statutory interpretation. Congress may intend a statute to cover "goods," whether now existing or after arising, in a statute such as the "theft of goods" statute. But when Congress expressly defines the subject of the statute as it has done here – a "printed publication" - it is not for the Courts to redefine that subject for Congress. The "theft of goods" statute does not purport to define what "goods" are the subject of the statute; any goods of sufficient value qualify. Not every document in existence qualifies as a printed publication.

### D. This Court Must Uphold Congress's Intent and Create a Consistent Standard for Foreign Prior Art

T.H.E. asserts that arguments about the original definition for "printed publications" are irrelevant because the '119 patent application clearly meets the current standard applied by the Federal Circuit. (T.H.E. Opposition, pp. 7-9.) T.H.E. utterly fails to grasp the issue at hand, that the standard applied recently in the Federal Circuit ignores Congress's intent. The most recent case law misapplies the "printed publication" standard and should be overruled. The purpose of the patent statute is to prevent foreign prior art that has been printed in a manner likely to be disseminated to

the United States from being removed from the public realm by a patent. *In re Tenney*, 254 F.2d at 624, 626. Nothing more is intended by the statute and nothing more should be included in its interpretation. The '119 patent application is sitting on microfilm in the CIPO with no index or catalog to indicate its location. Microfilm is not a means of printing that leads to dissemination and the lack of index or reference shows that it has not been published in a manner that would lead to dissemination.

## CONCLUSION

The Federal Circuit has issued conflicting opinions on the standard which should be applied in determining whether foreign prior art is invalidating as "printed publications." Bruckelmyer's Petition to this Court is timely and ripe. Only the Supreme Court can resolve the debate among the Federal Circuit judges.

The Petition for a Writ of Certiorari must be granted.

Dated: December, 2006

Respectfully submitted,

John B. Lunseth, II

*Counsel of Record*
**Briggs and Morgan, P.A.**
2200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
(612) 977-8400

*Counsel for Petitioner*